

ESTTA Tracking number: **ESTTA134895**

Filing date: **04/11/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	CBT Supply, Inc.
Granted to Date of previous extension	04/14/2007
Address	83 Jacobs Road Rockaway, NJ 07866 UNITED STATES

Name	JeffreyKorber
Granted to Date of previous extension	04/14/2007
Address	83 Jacobs Road Rockaway, NJ 07866 UNITED STATES

Attorney information	Bruce Haraguchi Seyfarth Shaw LLP 131 S. Dearborn Street, Suite 2400 Chicago, IL 60603 UNITED STATES bharaguchi@seyfarth.com Phone:312-460-5000
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Applicant Information

Application No	78751976	Publication date	02/13/2007
Opposition Filing Date	04/11/2007	Opposition Period Ends	04/14/2007
Applicant	Stengel, Peter J. 10717 Faulkner Ridge Circle Columbia, MD 21044 UNITED STATES		

Goods/Services Affected by Opposition

Class 020. First Use: 1996/12/31 First Use In Commerce: 1996/12/31 All goods and sevicees in the class are opposed, namely: Computer furniture

Related Proceedings	Opposition against Serial No. 78768870
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Attachments	opposition-logo.pdf (11 pages)(558207 bytes)
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Signature	/Bruce Haraguchi/
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Name	Bruce Haraguchi
Date	04/11/2007

In re Trademark Application Serial No.: 78/751976

V.

Applicant.

Opposition No.

NOTICE OF OPPOSITION

GROUNDS FOR OPPOSITION

- CH1 11205188.1

continuously used the trademark SMARTdesks and Design, depicted in Serial No. 78/751976, (“SMARTdesks Logo”) in connection with computer furniture, including computer desks and tables.

4. The SMARTdesks Logo was created in or about April 1999 at the direction of Jeffrey Korber for exclusive use by CBT. Mr. Korber hired a designer to create the SMARTdesks Logo, approved and adopted the Logo, and thereafter controlled the use of the Logo on behalf of CBT with respect to the nature and quality of goods and services provided under that trademark.

5. CBT continues to conduct business under the trade identity SMARTdesks, and identifies its products and services with the SMARTdesks trademark and SMARTdesks Logo (collectively, “SMARTdesks Marks”) as it has done since 1998 and 1999, respectively.

6. Among other things, CBT operates a website at www.smartdesks.com, which prominently displays the SMARTdesks Marks in connection with CBT’s computer furniture. This website has been a key component in CBT’s marketing activities since at least January 1998, always at the domain name www.smartdesks.com. Initially, the domain name was registered in December 1997 to CBT’s Supply, Inc.’s predecessor, Design Form, Inc. In or about April 2000, the [smartdesks.com](http://www.smartdesks.com) domain name was transferred to Smartdesks, Ltd., and then was transferred to CBT Supply, Inc. in or about December 2002. A printout from the WHOIS database and sample web pages are attached at Exhibit A, showing CBT Supply, Inc. as the current registrant and user of the www.smartdesks.com domain name.

7. By virtue of its longstanding, continuous use in commerce, CBT has built up considerable recognition, reputation and goodwill in and to the SMARTdesks Marks within the relevant market. The SMARTdesks Marks are and have been used under the control of CBT and

are associated exclusively with the products and services of CBT, making CBT the rightful owner of any and all applicable rights to those Marks.

8. Applicant, Peter J. Stengel¹, had substantial business dealings with CBT from at least 1997 to 2005, including time spent as an employee of CBT and as an outside consultant hired by CBT to perform specified services. As with Design Form, Inc., Mr. Korber was the President, CEO and sole Director of Smartdesks, Ltd. and CBT Supply, Inc. Mr. Stengel was never an owner or director of either Smartdesks, Ltd. or CBT Supply, Inc. During that time, it was CBT and not Applicant who manufactured, marketed and sold computer furniture under the SMARTdesks Marks. Any use by Applicant of the term “Smartdesk” or “Smartdesks” in connection with computer furniture prior to CBT’s adoption and use of the SMARTdesks Marks was merely *de minimis*.

9. On information and belief, the current owner of Serial Nos. 78/751976 and 78/768870 is Smartdesks, Inc., a corporation organized and existing under the laws of Maryland on or about November 16, 2005, with its principal place of business at 10717 Faulkner Ridge Circle, Columbia, Maryland 21044.

10. With full awareness of CBT’s rights to the SMARTdesks Marks, and while Applicant was under a consulting contract with CBT through December 31, 2005 to maintain CBT’s website at www.smartdesks.com, Applicant nevertheless filed Serial No. 78/751976 on November 11, 2005 seeking to register the SMARTdesks Logo, and filed Serial No. 78/768870 on December 7, 2005 seeking to register the word mark SMARTdesks, both for “computer

¹ In an office action response dated November 20, 2006, Applicant’s legal representative stated, “Applicant is now deceased and this Application has been assigned by his Personal Representative to Smartdesks, Inc.” However, the records of the Patent and Trademark Office still identify Peter J. Stengel as the owner of Serial No. 78/7519760. The term “Applicant” as used herein shall refer to Peter J. Stengel and/or Smartdesks, Inc., as necessary to identify the appropriate party.

furniture,” the same goods manufactured and sold by CBT under the identical Marks.

11. As part of his trademark application, Applicant submitted a business card listing the web address for *CBT's website* at www.smartdesks.com, as well as CBT's toll free telephone number, showing that Applicant was aware of CBT's ongoing use of the SMARTdesks Marks.

12. Despite actual knowledge of CBT's use of the SMARTdesks Marks, Applicant made the following declaration (emphasis added) by and through his legal representative, Scott Conwell, in conjunction with the filing of Serial Nos. 78/751976 and 78/768870:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; **to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive;** and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

On information and belief, Applicant's declaration was knowingly false.

13. The examining attorney subsequently issued descriptiveness refusals against Applicant's Serial Nos. 78/751976 and 78/768870 under Section 2(e), finding that each “proposed mark merely describes the goods,” and therefore was not entitled to registration on the Principal Register.

14. Applicant responded to the descriptiveness refusals by claiming to have had millions of dollars in sales of SMARTdesks products. These sales figures were attested to in a declaration by Marcia Stengel, President of Smartdesks, Inc., which accompanied Applicant's November 20, 2006 responses to the office actions. In reality, the sales figures and dates

claimed as evidence of trademark use by Applicant actually reflected Applicant's estimates of sales *by CBT* of SMARTdesks products.

15. Although the declaration of Marcia Stengel cites use by "applicant's licensees," no such license agreement existed between CBT and Applicant, and Applicant was not entitled to claim the benefit of trademark use by CBT. On information and belief, its attempt to do so was a deliberate attempt to mislead the Trademark Office for the purpose of overcoming the descriptiveness refusal under Section 2(e).

16. With its November 20, 2006 office action responses, Applicant also cited third party articles and references in an effort to convince the examining attorney that the SMARTdesks Logo had acquired distinctiveness. These articles referred to products and customers of CBT, not Applicant.

17. Applicant's November 20, 2006 office action responses also included a declaration by Jasen Stengel, identified as a Director of Smartdesks, Inc., stating that he is "thoroughly familiar with the website through which the products marketed under the 'SMARTdesks' trademark were sold on or before 1999."

18. As evidence of past and current trademark use by Applicant, the declaration of Jasen Stengel includes printouts of a website bearing the notice "Copyright © 1996-99 SMARTdesks™ Ltd." and listing the phone number 800-770-7042 and email address info@smartdesks.com. SMARTdesks Ltd. is a predecessor-in-interest of CBT Supply, Inc., and the listed phone number and email address were and remain the phone number and email address of CBT, not Applicant.

19. In response to the examining attorney's requirement for a new specimen of use, Applicant relied on the web pages submitted with the declaration of Jasen Stengel. Those pages

are described in Mr. Stengel's declaration as copies of web pages "as this website existed on or before 1999," along with "a detailed questionnaire which the customer will fill out in order to get a price quote."

20. On information and belief, the substitute specimen was not currently in use in commerce by Applicant in connection with "computer furniture" at the time Applicant filed Serial Nos. 78/751976 or 78/768870, or at the time of Applicant responded to the office actions requiring a new specimen of use.

21. On information and belief, Applicant, Scott Conwell, Jasen Stengel and Marcia Stengel have knowingly made false, material representations of fact regarding its ownership and use of the SMARTdesks Marks, for the purpose of obtaining a federal trademark registration.

22. As the rightful owner and user of the SMARTdesks Marks, CBT and Mr. Korber will be harmed by a registration granted to Applicant due to Applicant's false representations.

23. Applicant's use or proposed use of the SMARTdesks Marks is without any consent or authorization from CBT or Mr. Korber.

24. Applicant's proposed registration of the SMARTdesks Marks is without any consent or authorization from CBT or Mr. Korber.

25. If Applicant were permitted to register the SMARTdesks Marks for the goods listed in Applicant's application, customers and the relevant trade would likely be confused as to the source, sponsorship, or affiliation of such goods, thereby causing damage and injury to CBT and Mr. Korber. Persons already familiar with CBT's products and services would be likely to be confused as to whether Applicant's goods are authorized or sponsored by CBT, and such confusion in the trade and among customers inevitably would result in damage to CBT and Mr. Korber. Furthermore, any defect, objection or fault found with Applicant's goods would likely

reflect upon and injure the good reputation CBT has established for its products.

26. To the extent that the SMARTdesks Marks are found to describe the claimed goods, Applicant has failed to meet its burden of showing acquired distinctiveness, or that it is the party associated with such acquired distinctiveness. Therefore, Applicant is not entitled to a registration on the Principal Register.

27. In any event, Applicant has failed to establish that it is the user and rightful owner of the SMARTdesks Marks, and therefore is not entitled to own registrations for those Marks.

WHEREFORE, CBT Supply, Inc. and Jeffrey Korber respectfully request that this opposition be sustained, and that Application Serial No. 78/751976 to register the SMARTdesks Logo be denied.

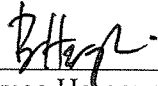
NOTICE OF PENDING LITIGATION ON THE SMARTDESKS MARKS

CBT Supply, Inc. and Mr. Korber note that the disputed ownership of the SMARTdesks Marks is the subject of pending litigation before the United States District Court for the District of Maryland, Civil Action No. 1:05-CV-03456 MJG, including claims by Applicant and counterclaims by CBT Supply, Inc. and Mr. Korber. In that case, the Court issued a Preliminary Injunction prohibiting Applicant from “communicating in a manner that would tend to mislead the public into believing that Plaintiffs [Applicant and Smartdesks, Inc.] are affiliated with, or a successor in interest to, Defendants [CBT Supply, Inc. and Jeffrey Korber] or affiliated with the smartdesks.com website.” Ownership of the SMARTdesks Trademarks is also at issue in

pending litigation before the Circuit Court for Howard County, Maryland, Case No. 13-C-05-064158, including claims by Applicant and counterclaims by CBT Supply, Inc. and Mr. Korber.

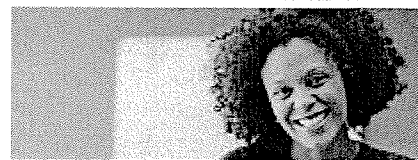
Dated: April 11, 2007

Respectfully submitted,



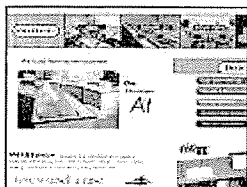
Bruce Haraguchi
SEYFARTH SHAW LLP
Attorneys for Opposers
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Chicago, Illinois 60603
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Fax: (312) 460-7000

EXHIBIT A



WHOIS Search Results

WHOIS Record For



smartdesks.com

Services from Network Solutions:

Certified Offer Service - Let us help you get this domain name!

Private Registration - Keep personal information for this domain private.

SSL Certificates - Get peace of mind with a secure certificate.

Site Confirm Seals - Display a security seal and gain visitor trust.

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SMARTDESKS.COM

Registrant:

CBT Supply Inc.
PO Box 391
Hibernia, NJ 07842
US

[Make this info
private](#)

Search ➤

Domain Name: SMARTDESKS.COM

Administrative Contact :

CBT Supply Inc.
jkorber@smartdesks.com
PO Box 391
Hibernia, NJ 07842
US
Phone: 8007707042
Fax: 8776207411

Technical Contact :

Administrator, DNS **
dnsadmin@BDOL.COM
3 Regency Plaza
Suite 23
PROVIDENCE, RI 02903
US
Phone: 401.276.4700
Fax: 401.276.4701

Go ➤

Record expires on 09-Dec-2011
Record created on 10-Dec-1997
Database last updated on 27-Jun-2006

Domain servers in listed order:

[Manage DNS](#)

[CUJO.BDOL.COM](#)
[DNS.INTAP.NET](#)

[Show underlying registry data for this record](#)

Current Registrar: NETWORK SOLUTIONS, LLC.
IP Address: 72.46.4.128 (ARIN & RIPE IP search)
IP Location: US(UNITED STATES)-RHODE ISLAND-PROVIDENCE
Record Type: Domain Name
Server Type: IIS 6
Lock Status: clientTransferProhibited
Web Site Status: Active
DMOZ [1 listings](#)
Y! Directory: [see listings](#)
Web Site Title: Classroom Layout at Smart Desks: Classroom Computer Furniture, Classroom Design, Training Room Furniture, Computer Workstations
Meta Description: Classroom Layouts at Smart Desks. Your source for classroom computer furniture, classroom designs, training room furniture and computer workstations
Meta Keywords: classroom layout,classroom computer furniture,classroom design,training room furniture,computer workstations,computer desks,laptop desk,multimedia furniture,computer desks workstations,training furniture,computer training furniture,computer workstation de
Secure: No
E-commerce: Yes
Traffic Ranking: 3
Data as of: 08-Nov-2006

BUY THE AVAILABLE EXTENSIONS FOR THIS DOMAIN NAME

smartdesks	<input checked="" type="checkbox"/>	.org
smartdesks	<input checked="" type="checkbox"/>	.info
smartdesks	<input checked="" type="checkbox"/>	.biz
smartdesks	<input checked="" type="checkbox"/>	.tv
smartdesks	<input checked="" type="checkbox"/>	.us
smartdesks	<input checked="" type="checkbox"/>	.cc
smartdesks	<input checked="" type="checkbox"/>	.ws
smartdesks	<input checked="" type="checkbox"/>	.bz
smartdesks	<input checked="" type="checkbox"/>	.vg
smartdesks	<input checked="" type="checkbox"/>	.gs
smartdesks	<input checked="" type="checkbox"/>	.tc
smartdesks	<input checked="" type="checkbox"/>	.ms

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e.g. networksolutions.com

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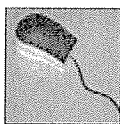
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